

AF/3622



Docket 79909F-P
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Dale F. McIntyre, et al

COMPUTER SOFTWARE
PRODUCT AND SYSTEM FOR
ADVERTISING BUSINESS AND
SERVICES

Serial No. US 09/451,315

Filed 30 November 1999

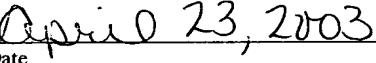
Commissioner for Patents
Box AF
Washington, D.C. 20231

Group Art Unit: 3622

Examiner: Jeffrey D. Carlson

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Deborah J. Walczak


Date

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Sir:

APPEAL BRIEF TRANSMITTAL

Enclosed herewith in triplicate is Appellants' Appeal Brief for the above-identified application.

The Commissioner is hereby authorized to charge the Appeal Brief filing fee to Eastman Kodak Company Deposit Account 05-0225. A duplicate copy of this letter is enclosed.

Respectfully submitted,



Attorney for Appellants
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Enclosures



Dale J. Walczak
#9/Appeal
Brief

Docket 79909F-P
Customer No. 01333
5-6-03

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Deborah J. Walczak
Deborah J. Walczak

April 23, 2003
Date

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GROUP 3600

Sir:

APPEAL BRIEF PURSUANT TO 37 C.F.R. 1.192

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APPELLANT'S BRIEF ON APPEAL

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 1-34 which was contained in the Office Action mailed December 2, 2002.

A timely Notice of Appeal was filed February 25, 2003.

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Real Party In Interest

As indicated above in the caption of the Brief, the Eastman Kodak Company is the real party in interest.

Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

Status Of The Claims

Claims 1-34 have been rejected and are appealed.

Appendix I provides a clean, double spaced copy of the claims on appeal.

Status Of Amendments

An Amendment under 37 CFR 1.116 was mailed to the USPTO on February 5, 2003. Amendments were made to the specification and claims 17 and 32. The claims as set forth in Appendix I reflect amendments set forth in this response.

An Advisory Action March 13, 2003, the Examiner indicated that the proposed amendments would be entered. However, the amendment did not place the case in condition for allowance.

Summary Of The Invention

The present invention is directed to a computer software program that is used to generate a game. The software when loaded on to a personal computer causes the personal computer to perform the steps of:

locating and selecting at least one digital image supplied by a user; incorporates the image into a game; and

automatically displays a prestored message to the user upon playing or completion of the game.

In some cases, the user is automatically forwarded to a remote computer site upon completion of the game.

Issues For Review By The Board

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether claims 1, 7, 8, 12 and 14-16 are unpatentable under 35 USC § 102(b) over US Patent 5,791,991 to Small.
2. Whether claims 2, 10, 11, 13, 14, 15, 17, 22, 23 and 25-33 are unpatentable under 35 USC § 103(a) over US Patent 5,791,991 to Small.
3. Whether claims 3-6 and 18-21 are unpatentable over Small in view of US Patent 6,203,427 to Walker.
4. Whether claims 9 and 24 are unpatentable under 35 USC § 103(a) over Small in view of US Patent 6,336,099 to Barnett et al.
5. Whether claim 11 is unpatentable under 35 USC § 103(a) over Small in view of US Patent 5,679,075 to Forrest et al.

Grouping Of Claims

Group I: Claims 1, 3-9, 11-16 stand together as a group.

Group II: Claims 2, 10, 17-34 stand together as a group.

Arguments

The Rejection

Group I - Claims 1, 3-9, 11-16

- A. The rejection of claims 1, 7, 8, 12, 14-16 under 35 USC § 102(b) as being anticipated by Small.

In order for a claim to be anticipated, each and every element of the claim must be disclosed in a single reference. Independent claim 1 is specifically directed to a computer program such that when loaded onto a personal computer will cause the computer to perform the steps of:

1. locating and selecting at least one digital image supplied by a user and provided in the storage media;
2. incorporating the image into a game; and

3. automatically displaying a prestored message to the user upon completion of the game.

The Small reference is illustrative of a problem associated with a prior art game. The Small reference discloses a game that uses images that have no particular relevance to the user. The images employed in the Small reference are not those under the control of the user. Quite the contrary, the images used are prestored types of images provided by an advertiser. The present invention increases the relevancy and value of the promotional space by utilizing personal images supplied by the user into the playing of the game. By incorporating personal images of the user there is provided a high degree of promotional efficiency by making the game more relevant to the user. In the Small reference, the game matrix is mapped to respective customer product categories or category numbers. The category numbers of Small can be randomly or pseudo randomly generated by CPU2. See column 5, lines 10-13. The Small reference fails to teach or suggest the utilization of an image supplied by the user. Thus, the Small reference could not anticipate the present invention and the reference lacks at least one of the claim elements. See also, column 6, lines 6-34 and column 7, lines 1-15 of Small where it is disclosed that the customer selects eight of the product categories. The consumer is selecting categories that are predetermined. There is no teaching or suggestion that the consumer provide images which are incorporated as part of the game. Thus, the statement by the Examiner in the final action that "the user is therefore responsible for supplying the image from the storage medium to the PC game program client" is not supported by the Small reference.

Applicants respectfully submits that the Small reference does not anticipate or render obvious the present invention.

Group II - Claims 2, 10, 17-34

- B. Rejection of claims 2, 10, 11, 13, 14, 15, 17, 22, 23, 25-34 under 35 USC § 103(a) as being unpatentable over Small.

Dependent claim 2 and independent claim 17 is similar to independent claim 1 except that they include the additional limitation of automatically forwarding the user to a remote computer site upon playing or completion of the game. As previously discussed with independent claim 1, claim 17 includes the selecting of at least one digital image supplied by a user providing a storage medium and using that image in the game. As previously discussed, the Small

reference does not teach or suggest this limitation. While Small may disclose the use of hot links, it does not teach or suggest that the hotlinks be automatically employed for forwarding the user automatically upon completion of the game. Thus, it is not only the fact that user will go to another site, but this forwarding occurs upon a specific occurrence of an event, i.e. the completion of the game. Hereagain, the prior art fails to teach or suggest this. Thus, the prior art fails to teach or render applicants' invention obvious.

See arguments. The Examiner also rejected claims 3-6 and 18-21 under 35 USC § 103(a) as being unpatentable over Small in view of Walker. However, these claims depend at least ultimately upon independent claim 1 and/or 17 and are therefore patentably distinct for the reasons previously discussed. Likewise, claims 9, 10 and 24 depend at least ultimately upon independent claims 1 and 17 and is therefore patentable for the same reasons as previously discussed.

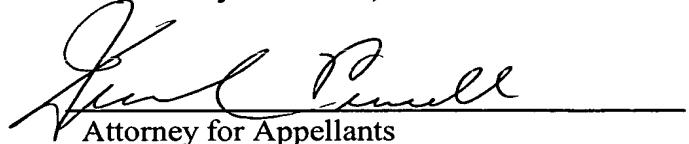
Summary

In Summary, the prior art fails to teach or suggest the utilization of consumer user images in a game as taught and claimed by applicants.

Conclusion

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims 1-34.

Respectfully submitted,



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Appendix I - Claims on Appeal

1.(Once Amended) A computer software product comprising a computer readable storage medium having a computer program which when loaded into a personal computer causes the personal computer to perform the following steps:

- a. locating and selecting at least one digital image supplied by a user and provided in said storage medium;
- b. incorporating said image in a game; and
- c. automatically displaying a prestored message to said user upon playing or completion of said game.

2. A computer software product according to claim 1 wherein a user of said computer program is automatically forwarded to a remote computer site upon playing or completion of said game.

3.(Once Amended) A computer software product according to claim 1 wherein said computer software product includes a contest entry number that can be verified.

4. A computer software product according to claim 3 wherein said contest entry number is verified by calling a phone number and providing said contest entry number.

5. A computer software product according to claim 3 wherein said contest entry number is verified automatically by said computer program accessing a remote computer and providing said contest number so as to determine if the user is a winner.

6. A computer software product according to claim 5 wherein contest number is encrypted.

7. A computer software product according to claim 1 wherein said program includes providing a product coupon.

8. A computer software product according to claim 7 wherein said coupon is provided by printing a coupon in response to instructions by said computer software.

9. A computer software product according to claim 8 further comprising means for limiting the number of times said coupon may be printed.

10. A computer software product according to claim 2 wherein said remote computer forwards a product coupon to said personal computer for printing by said personal computer and used by said user.

11. A computer software product according to claim 1 wherein said computer readable storage medium comprises a Computer Disc.

12. A computer software product according to claim 1 wherein said computer readable storage medium comprises a remote computer system.

13. A computer software product according to claim 1 wherein said game is a concentration game wherein a plurality of sections are provided that cover an image, a plurality of paired images are associated with said plurality of sections and when two like images are selected a portion of said image covered by said sections is revealed.

14. A computer software product according to claim 1 wherein said game comprises a puzzle.

15. A computer software product according to claim 1 wherein said game comprises a square section puzzle.

16. A computer software product according to claim 1 wherein said locating and selecting is automatically done by said program.

17.(Twice Amended) A computer software product comprising a computer readable storage medium having a computer program which when

loaded into a personal computer causes the personal computer to perform the following steps:

- a. locating and selecting at least one digital image supplied by a user and provided in a storage medium;
- b. incorporating said image in a game; and
- c. automatically forwarding the user to a remote computer site

upon playing or completion of said game.

18.(Once Amended) A computer software product according to claim 17 wherein said computer software product includes a contest entry number that can be verified.

19. A computer software product according to claim 17 wherein said contest entry number is verified by calling a phone number and providing said contest entry number.

20. A computer software product according to claim 17 wherein said contest entry number is verified automatically by said computer program accessing a remote computer and providing said contest number so as to determine if the user is a winner.

21. A computer software product according to claim 20 wherein contest number is encrypted.

22. A computer software product according to claim 17 wherein said program includes providing a product coupon.

23. A computer software product according to claim 22 wherein said coupon is provided by printing a coupon in response to instructions by said computer software.

24. A computer software product according to claim 23 further comprising means for limiting the number of times said coupon may be printed.

25. A computer software product according to claim 17 wherein said remote computer forwards a product coupon to said personal computer for printing by said personal computer and use by said user.

26. A computer software product according to claim 17 wherein said computer readable storage medium comprises a Computer Disc.

27. A computer software product according to claim 17 wherein said computer readable storage medium comprises a remote computer system.

28. A computer software product according to claim 17 wherein said game is a concentration game wherein a plurality of sections are provided that cover an image, a plurality of paired images are associated with said plurality of

sections and when two like images are selected a portion of said image covered by said sections is revealed.

29. A computer software product according to claim 17 wherein said game comprises a puzzle.

30. A computer software product according to claim 17 wherein said game comprises a square section puzzle.

31. A computer software product according to claim 17 wherein said locating and selecting is automatically done by said program.

32.(Once Amended) A computer software product comprising a computer readable storage medium having a computer program which when loaded into a personal computer causes the personal computer to perform the following steps:

- a. locating and selecting at least one digital image supplied by a user and provided in said storage medium;
- b. automatically forwarding a user on said personal computer to a remote computer site upon a predetermined action so that said user can view a product advertisement.

33.(Once Amended) A computer software product according to claim 32 wherein said predetermined action comprises playing of a game.

32.(Twice Amended) A computer software product comprising a computer readable storage medium having a computer program which when loaded into a personal computer causes the personal computer to perform the following steps:

- a. locating and selecting at least one digital image supplied by a user and provided in said storage medium;
- b. automatically forwarding a user on said personal computer to a remote computer site upon a predetermined action for viewing a product advertisement by said user.

33.(Once Amended) A computer software product according to claim 32 wherein said predetermined action comprises playing of a game.

34. A computer software product according to claim 32 wherein said predetermined action comprises the selection of an offering on said product advertisement.